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10/788,532	02/27/2004	Alan Scott Hodes		6928

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 January 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>27 February 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   No new claims have been added. Claims 1-2, 4, 13-14, and 21-25 have been amended.

Therefore, claims 1-25 are pending in this office action.

Double Patenting

2.   Claims 1, 6, 13, 14, and 21 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending

Application No. 11/151,781. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the only difference in the wording of the claims is

the intended use of the invention. The claims of Application number 11/151,781 seem to be

directed to any and all text documents whereas the claims of 10/788, 532 are directed specifically

to documents consisting of patent claims. Since patent claims are simply text documents, the

claims in the two applications are found to be obvious variations of one another. Appropriate

action should be taken to resolve the matter. Appropriate courses of action include amendment

of the claims and/or the filing of a terminal disclaimer.

     This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Claim Rejections - 35 USC § 101

     35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.   Claims 3-4 are rejected under 35 U.S.C. 101 because the claim is directed to non-

statutory subject matter.

Claim 3 is rejected under 35 U.S.C. 101 because the claim clearly recites a computer

program that is not embodied on a computer readable medium. A computer program that is not

embodied on an acceptable computer readable medium is nothing more than an abstract idea.

When the computer program product is recorded on an acceptable computer readable medium it

becomes structurally and functionally interrelated to the medium and will be statutory in most

cases since use of technology permits the function of the computer program product to be

realized.

Simply amending the claims to recite '..executing a program stored in a computer

readable storage medium...' would overcome the rejection. Appropriate correction is required.

Claim 4 is rejected because it inherits the deficiencies of claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1-5, 11-14, 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent Application Publication Number 2002/0111941 issued to Claude Roux et al.

(hereinafter "Roux") in further view of U.S. Patent Application Publication Number

2004/0181427 issued to Gregory A. Stobbs et al. (hereinafter "Stobbs").

Claim 1:

Roux discloses a method of analysis regarding at least one patent claim, comprising:

a) determining a correspondence of the portions of the at least one patent claim to

concept nodes of an ontology *(Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph*

[0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to

note that a patent claim is simply text. So performing a scan and search on a text document is the same as

performing a scan and search on a patent claim. Further note that the 'semantic lattice' is a conceptual graph of

relationships between words that is built using a thesaurus or <u>ontology</u>.);

b) determining a correspondence of the portions of at least one instance to the concept

nodes of the ontology *(Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-*

11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; Again note that a one 'instance' or

embodiment is simply text. The process for steps b) and a) are identical, so the same rejection applies.); and

c) processing the determined correspondence of the portions of the at least one patent

claim and the determined correspondence of the portions of the at least one instance *(Roux:*

paragraph [0041] and paragraph [0042], lines 1-3 and paragraph [0043], lines 1-7).

Roux does not explicitly disclose wherein a result of processing the determined

correspondence of the portions of the at least one patent claim portions and the determined

correspondence of the portions of the at least one instance includes a determination of whether

the at least one instance reads on the at least one patent claim.

However, Stobbs discloses wherein a result of processing the determined correspondence

of the portions of the at least one patent claim portions and the determine correspondence of the

portions of the at least one instance includes a determination of whether the at least one instance

reads on the at least one patent claim *(Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8*

and paragraph [0109], lines 1-10 and Abstract and Fig. 9; Note specifically the 'claim validity analysis module' 190

and also 'product coverage / infringement analysis' 188.).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the teachings of Roux with the teachings of Stobbs noted above. The

skilled artisan would have been motivated to improve the teachings of Roux with the teachings

of Stobbs per the above such that it is possible to discover documents, products, or product

descriptions that validate, invalidate, or infringe upon a patent claim *(Stobbs: paragraph [0107], lines*

1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).

Claim 2:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted

above, and Roux further discloses wherein:

step a) includes completing a claim record for each of the at least one patent claim under

study indicating the correspondence determined in step a) *(Roux: paragraph [0040]; The claim records*

and instance records simply appear to be portions of claims or documents which have established a mapping to

concept nodes and are then stored (Applicant's Specification paragraph [0083], lines 7-11). Furthermore, the claims

and documents are simply text. Clearly the Roux reference shows storing an established mapping to a concept node

(Roux: paragraph [0040]).);

step b) includes completing an instance record for each of the at least one instance under

study *(Roux: paragraph [0040]);* and

step c) includes processing the completed claim records and the completed instance

records *(Roux: paragraph [0040]; Surely the process described in paragraph [0040] requires processing the*

mapping to the concept nodes ('claim record' or 'instance record').).

Claim 3:

The combination of Roux and Stobbs discloses all the elements of claim 2, as noted

above, and Stobbs further discloses wherein:

the claim record and the instance record are embodied in a computer-readable medium

(Roux: paragraph [0040]); and

step c) includes a computer executing a program to process the claim record and the

instance record *(Roux: paragraph [0040])*.

Claim 4:

The combination of Roux and Stobbs discloses all the element of claim 3, as noted above,

and Roux further discloses wherein:

step c) further includes the computer executing a program to process an index to instance

records, by concept node, based on at least one concept node indicated in at least one of the

completed claim records *(Roux: paragraph [0063], lines 1-7; The Roux reference clearly discloses creating an*

index for records based on concept nodes. The invention set forth in claim 4 is clearly an obvious variation of the

what Roux discloses in paragraph·[0063].).

Claim 5:

The combination of Roux and Stobbs disclose all the elements of claim 2, as noted above,

and Roux further disclose wherein:

completing the claim record and completing the instance record includes indicating the

concept node to which each portion of the corresponding claim and instance, respectively,

corresponds *(Roux: paragraph [0039] and paragraph [0052]; The generation of a semantic lattice (ontology*

connecting concept nodes) must involve some form of indication of corresponding conceptual nodes.),

processing the completed claim records and the completed instance records includes

determining a comparison of the concept nodes indicated by claim records to concept nodes

indicated by instance records *(Roux: paragraph [0043], lines 1-7).*

Claim 11:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted

above, and Roux further discloses wherein:

step c) includes comparing the determined correspondence of the portions of the at least

one patent claim to the determined correspondence of the portions of at least one instance *(Roux:*

paragraph [0041] and paragraph [0043], lines 1-7).

Claim 12:

The combination of Roux and Stobbs discloses all the elements of claim 11, as noted

above, and Roux further discloses wherein:

step c) includes processing the ontology to determine a relation between the scope of the

concepts to which portions of the at least one patent claim correspond and the scope of the

concepts to which respective portions of the at least one instance correspond *(Roux: paragraph*

[0041] and paragraph [0042], lines 1-3 and paragraph [0043], lines 1-7).

Claim 13:

Claim 13 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 14:

Claim 14 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 18:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted

above, and Roux further discloses wherein:

the step of determining a correspondence of the portions of the at least one patent claim

to the concept nodes of an ontology includes , for each of at least one of the portions, adding to

the ontology a concept node to which that portion corresponds *(Roux: paragraph [0040], lines 11-15*

and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an

ontology (semantic lattice).).

Claim 19:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted

above, and Roux further discloses wherein:

the step of determining a correspondence of the portions of at least one instance to the

concept nodes of the ontology includes, for each of the at least one of the portions, adding to the

ontology a concept node to which that portion corresponds *(Roux: paragraph [0040], lines 11-15 and*

paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology

(semantic lattice).).

Claim 20:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted

above, and Roux further discloses wherein:

the step of determining a correspondence of the portions of the at least one patent claim

to the concept nodes of an ontology includes, for each of the at least one of the portions *(Roux:*

paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and

paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a patent claim is simply text. So

performing a scan and search on a text document is the same as performing a scan and search on a patent claim.

Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a

thesaurus or ontology.), adding to the ontology a concept node which that portions corresponds

(Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the

adding of a concept node to an ontology (semantic lattice).); and

the step of determining a correspondence of the portions of at least one instance to the

concept nodes of the ontology includes, for each of the at least one of the portions, adding to the

ontology a concept node to which that portion corresponds *(Roux: paragraph [0040], lines 11-15 and*

paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology

(semantic lattice).).

Claim 21:

Claim 21 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 22:

The combination of Roux and Stobbs discloses all the elements of claim 21, as noted

above, and Roux further discloses a system comprising:

ontology storage holding the ontology *(Roux: Fig. 1, 103 and paragraph [0039] and paragraph*

[0052]; The semantic lattice is composed of ontologies.).

Claim 23:

The combination of Roux and Stobbs discloses all the elements of claim 21, as noted

above, and Roux further discloses a system comprising:

document storage, holding at least one document, wherein the at least one document

embodies the plurality of instances *(Roux: paragraph [0002])*;

wherein each instance record includes at least one link record configured to hold a link to

the separate one of the plurality of instances embodied in the at least one document *(Roux:*

paragraph [0051] and paragraph [0052]; Note specifically that each concept is connected (linked to) other concepts

through relation nodes.).

Claim 24:

The combination of Roux and Stobbs discloses all the elements of claim 23, as noted

above, and Roux further discloses wherein:

the at least one link included which each instance record is configured to hold includes a

plurality of links, wherein each link is a link to a separate portion of the instance with which the

instance record is associated *(Roux: paragraph [0051] and paragraph [0052]; Note specifically that each*

concept is connected (linked to) other concepts through relation nodes. If there is a plurality of relations, there

would be a plurality of links or connections.).

Claim 25:

The combination of Roux and Stobbs discloses all the elements of claim 23, as noted

above, and Roux further discloses a system comprising:

an instance record index comparing a plurality of entries *(Roux: paragraph [0038]; The use of*

indexes for records in a database is well known in the art.),

wherein, each entry of the instance record index

corresponds to a separate concept node in the ontology, and is configured to hold

an indication of the instance records holding an indication of the concept node to which that

entry of the instance record corresponds *(Roux: paragraph [0038], lines 7-10).*

5.   Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roux in view

of Stobbs and further in view of U.S. Patent Number 6,711,585 issued to Max Copperman et al.

(hereinafter "Copperman").

Claim 6:

The combination of Roux and Stobbs discloses all the elements of claim 5, as noted

above, but the previously mentioned combination does not explicitly disclose wherein:

determining a comparison includes determining whether there is one to one

correspondence between concept nodes in claim records and concept nodes in instance records.

However, Copperman discloses wherein determining a comparison includes determining

whether there is a one to one correspondence between concept nodes in claim records and

concept nodes in instance records *(Copperman: column 15, lines 8-11).*

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the previously mentioned combination with the teachings of Copperman

noted above. The skilled artisan would have been motivated to improve the previously

mentioned combination per the above such that the use of concept nodes in a document retrieval

system provides for faster and more relevant responses than a content-based retrieval system

(Copperman: column 2, lines 53-59).

Claim 7:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6,

as noted above, and Roux further discloses wherein:

the comparison means is among the concept nodes indicated by each of a plurality of

ones of the instance records, respectively, and the concept nodes indicated by one claim record

(Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]).

Claim 8:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 7,

as noted above, and Roux further discloses wherein:

the comparison includes considering the scope of the concepts corresponding to the

concept nodes indicated by each instance record, respectively, relative to the scope of the

concepts corresponding to the concept nodes indicated by the one claim record *(Roux: paragraph*

[0041] and paragraph [0043], lines 1-7 and paragraph [0052]).

Claim 9:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6,

as noted above, and Roux further discloses wherein:

the comparison is among the concept nodes indicated by each of a plurality of ones of the

claim records, respectively, and the concept nodes indicated by one instance record *(Roux:*

paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]).

Claim 10:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6,

as noted above, and Roux further discloses wherein:

the comparison is among the concept nodes indicated by each of a plurality of ones of the

claim records, respectively, and the concept nodes indicted by one instance record *(Roux:*

paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]).

6.   Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roux in

view of Stobbs and further in view of Non-Patent Literature Article titled "Generating Patent

Claims From Interactive Input" issued to Svetlana Sheremetyeva et al. (hereinafter

"Sheremetyeva").

Claim 15:

The combination of Roux and Stobbs discloses all the element of claim 14, as noted

above, and Roux further discloses a method comprising:

determining a correspondence of the portions of an embodiment to the concept nodes of

the ontology *(Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and*

paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a description of

an embodiment of a invention is simply text. So performing a scan and search on a text document is the same as

performing a scan and search on a description of an embodiment of an invention. Further note that the 'semantic

lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology.).

The previously mentioned combination does not explicitly disclose processing the

determined correspondence of the embodiment portions and formulating the at least one patent

claim based at least in part thereon.

However, Sheremetyeva discloses processing the determined correspondence of the

embodiment portions and formulating the at least one patent claim based at least in part thereon

(Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Sheremetyeva noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the system and method aid an inventor in composing patent claims *(Sheremetyeva: page 2, left column, lines 34-37).*

Claim 16:

The combination of Roux, Stobbs, and Sheremetyeva discloses all the elements of claim 15, as noted above, and Sheremetyeva further discloses:

the formulated at least one patent claim is a first formulated at least one patent claim *(Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14; The reference clearly shows formulating a patent claim. Surely one of the formulated claims has to be a first claim.)*; and

the method further comprises

formulating a second at least one patent claim *(Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14; If one can generate a first patent claim, one can generate a second patent claim.).*

Neither Roux nor Sheremetyeva explicitly discloses wherein the analysis of the patent claim consists at least in part on the determination of whether the at least one prior art instance renders the first at least one patent claim unpatentable.

However, Stobbs discloses wherein the patent claim analysis consists at least in part on the determination of whether the at least one prior art instance renders the first at least one patent claim unpatentable *(Stobbs: Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the further teachings of Stobbs noted above. The skilled artisan would have been motivated to improve previously mentioned combination with the further teachings of Stobbs per the above such that it is possible to discover and consider documents, products, or product descriptions that validate, invalidate, or infringe upon a patent claim *(Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).*

Claim 17:

The combination of Roux and Stobbs discloses all the elements of claim 14, as noted above, and Roux further discloses:

determining a correspondence of the portions of an embodiment to the concepts nodes of the ontology *(Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a description of an embodiment of a invention is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a description of an embodiment of an invention. Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology.).*

Roux does not explicitly disclose wherein the correspondence of at least one prior art instance is considered in the analysis of a patent claim. However, Stobbs discloses wherein the

correspondence of at least one prior art instance is considered in the analysis of a patent claim

(Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and

Abstract and Fig. 9).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the teachings of Roux with the teachings of Stobbs noted above. The

skilled artisan would have been motivated to improve the teachings of Roux with the teachings

of Stobbs per the above such that it is possible to discover and consider documents, products, or

product descriptions that validate, invalidate, or infringe upon a patent claim *(Stobbs: paragraph*

[0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).

Neither Roux nor Stobbs discloses processing the determined correspondence of the

embodiment portions and formulating at least one patent claim based at least thereon. However,

Sheremetyeva discloses processing the determined correspondence of the embodiment portions

and formulating at least one patent claim based at least thereon *(Sheremetyeva: Abstract, lines 4-5 and*

page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the previously mentioned combination with the teachings of Sheremetyeva

noted above. The skilled artisan would have been motivated to improve the previously

mentioned combination per the above such that the system and method aid an inventor in

composing patent claims *(Sheremetyeva: page 2, left column, lines 34-37).*

Response to Arguments

Applicant Argues:

The double patenting rejection, while provisional only, no longer applies in any event given the
amendment to claim 1, which now incorporates a feature that is a generic version of the feature recited in

dependent claims 13 and 14. It is noted that claims 13 and 14 were not implicated in the double patenting rejection.

In addition, Applicant respectfully submits that the Examiner is in error in making the assertion of an "obvious variation" that "patent claims are simply text documents." Applicant does not waive the right, by amending the claims, to challenge this assertion in the future, should it become necessary.

Examiner Responds

Examiner is not persuaded. The provisional rejection of claims 1 and 6 is upheld

because the claims to the other co-pending application have been amended in the same manner.

Furthermore, due to the amendment submitted by the Applicant, claims 13, 14, and 21 are now

also provisionally rejected. This provisional rejection is upheld based upon the Examiner's

position that the claims are obvious variations because patent claims are simply text documents.

Therefore, both claims perform the same operation on text documents. The Examiner's position

with respect to this issue (i.e., "patent claims are simply text documents") is elaborated below.

The provisional rejection is upheld.

Applicant Argues:

Taking claim 1 as an example only, this claim includes (even before amendment) a feature of "a) determining a correspondence of the portions of the at least one patent claim to the concept nodes of an ontology." This feature is not "either expressly or inherently described" in Roux. The Examiner's statement that "a patent claim is simply text" (with which Applicant vehemently disagrees) does not remove the requirement that a reference, to be anticipatory, must "either expressly or inherently describe" every feature.

The Examiner appears to agree that Roux does not expressly describe every feature recited in the rejected claims.

Examiner Responds:

Examiner is not persuaded. It is the Examiner's position that an operation that can be

performed on one type of text document can be performed on any type of text document. It is a

fact that a patent claim is simply text. This leads to the conclusion that any operation that can be performed on a text document can also be performed on the text of a patent claim.

Therefore, the Roux reference, when read in this light discloses many features of the Applicant's claimed invention. It is important to note that, due to Applicant's amendment, the claims stand rejected under 35 U.S.C. 103(a). Clearly it is obvious to one of ordinary skill in the art to adapt an operation on text documents to also be performed on the text of a patent claim.

Finally, it is important to note that the Applicant did not provide any support for the allegation that the text of patent claims is different from the text of ordinary text documents. In fact, the only attempt presented to refute the Examiner's prima facie case has been the Applicant's own arguments and opinions. No evidence has been presented to support the Applicant's arguments and opinions. The Examiner notes the rule set forth in 37 C.F.R. 1.111(b) which requires Applicant to "distinctly and specifically point out errors" in the Examiner's office action. Furthermore, it should be noted that arguments, opinions, or conclusions of Applicant and the Applicant's counsel cannot take the place of evidence (See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964)).

The Examiner will maintain this interpretation of the references until evidence or support is provided to prove this standpoint wrong. Therefore, the claims remain rejected under 35 U.S.C. 103(a).

Applicant Argues:

Turning now to the rejection, in the first place, the Examiner notes with particular respect to the rejection of claim 2 that paragraph [0049] of Stobbs discloses "The claims Table clearly contains claim records." The "claims Table 60" does not, however, indicate a determined correspondence of portions of at least one patent claim to concept nodes of an onotology (which is a rough statement of "indicating the correspondence determined in step a"). Rather, as recited at paragraph [0049] of Stobbs,

The claims Table 62 stores the claim text, and indicia as to whether the claim is independent or dependent, and an adjusted claim word count that is used as a claim breadth metric.

Examiner Responds:

This argument is rendered moot in light of new grounds of rejection. Due to the

clarifying amendment added by the Applicant, the Examiner has interpreted claim 2 differently.

It now appears that the Roux reference discloses all limitations of claim 2. A brief explanation

of the Examiner's current position is given in the preceding rejection. Claim 2 now stands

rejected under 35 U.S.C. 103(a).

Applicant Argues:

In both the case of the Product Coverage / Invalidity Analysis module 188 and of the Validity Analysis module 190, there is no "processing the determined correspondence [to an ontology] of the at least one patent claim and the determined correspondence [to the ontology] of the at least one instance." No ontology is involved whatsoever.

The Examiner contends "The skilled artisan would have been motivated to improve the teachings of Roux with the teachings of Stobbs...such that it is possible to discover documents, products or product descriptions validate, invalidate, or infringe upon a patent claim." In the first place, as discussed above, Stobbs only discloses finding possibly infringing and possibly invalidating materials. Furthermore, at best, Stobbs suggests the desirability of finding potentially infringing or invalidating references. There is nothing in Stobbs that suggests somehow modifying Roux to find actually infringing or actually invalidating references. To the extent it may be well known that it is desirable to find actually infringing or actually invalidating references, there is nothing to suggest modifying Roux to operate on patent claims at all, let alone to find actually infringing or actually invalidating references.

Examiner Responds:

Examiner is not persuaded. First, the Examiner did not cite the Stobbs reference with respect to comparison of nodes of concept trees using ontologies. The Roux reference is cited to disclose that subject matter.

Further, it is clear that Stobbs discloses discovering documents, products, or product descriptions which validate, invalidate, or infringe upon a patent claim *(Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).*

In order to make this abundantly clear, portions of the Stobbs reference are now reproduced:

> **Abstract:** "Moreover, patents and/or clusters are linked to the Internet in order to determine what products might be covered by the claims of the patents or whether materials on the Internet might render the patent claims invalid."

> **Paragraph [0108]:** "Internet usage engine 182 includes the additional functionality of searching Internet web pages that are relevant for infringement analysis and validity analysis."

These along with other cited references clearly disclose that the Stobbs reference teaches discloses discovering documents, products, or product descriptions which validate, invalidate, or infringe upon a patent claim. Therefore, the rejections under 35 U.S.C. 103(a) are upheld.

Applicant Argues:

In the first place, "claim records" are mentioned nowhere in Copperman, contrary to the Examiner's allegation. Furthermore, classifications corresponding one-to-one to concept nodes has nothing to do with determining a correspondence of concept nodes to concept nodes.

Examiner Responds:

Examiner is not persuaded. Surely if the invention set forth in the Copperman reference

only permits one-to-one concept node mapping then the invention has some means of

determining if there is a one-to-one correspondence of concept nodes to concept nodes. If it had

no means of determining if there is a one-to-one mapping, how would it know not to permit a

two-to-one mapping? It is clear this determination process must be present. The rejections

given under 35 U.S.C. 103(a) are upheld.

Applicant Argues:

At best, Sheremetyeva elicits from an inventor a correspondence of claim elements to a conceptual schema. For example, see page 3, "the system guides the user through the paces of describing every essential feature of the invention." Sheremetyeva's formulated claim is the goal, and the formulated claim is based on the claim elements provided by the inventor. On the contrary, according to claim 15, the formulated at least one patent claim is one that can then be tested against the prior art (see text of claim 14).

Furthermore, as recited in claim 16, for example, a result of testing the formulated at least one patent claim can be used as input to formulating other patent claims. The Examiner contends that "If one can generate a first patent claim, one can generate a second patent claim." While this may be true, there is more to claim 16 than this, and the Examiner is not free to ignore recitations in claim 16. In fact, as the Examiner concedes, Sheremetyeva does not even disclose analyzing patent claims to determine whether it is unpatentable. Given that, it is illogical to content that Sheremetyeva discloses formulating "a second patent claim" based on such determination.

Examiner Responds:

Examiner is not persuaded. The office action above is very clear in citing the portions of

the references that read on the Applicant's claims. It is clear that Sheremetyeva discloses

formulating the at least one patent claim *(Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines*

34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14).

The Examiner also maintains the fact that if a first patent claim can be formulated, then a second patent claim can be formulated. There is no evidence submitted to suggest that the Sheremetyeva reference only formulates one patent claim and never formulates a second patent claim.

And finally, as noted in the above office action, each element of the Applicant's claimed invention has been mapped to the prior art over the combination of Roux, Stobbs, and Sheremetyeva. While each reference may fail to show a certain portion of claim 15 or claim 16, the combination as a whole discloses each and every element of the Applicant's **claimed invention**. This rejection is a 35 U.S.C. 103(a) obviousness rejection over a combination of references not a 35 U.S.C. 102 rejection over a single reference.

Since the previously mentioned combination discloses, or at the very least suggests, each and every element of the Applicant's **claimed invention**, the rejections given under 35 U.S.C. 103(a) are upheld.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
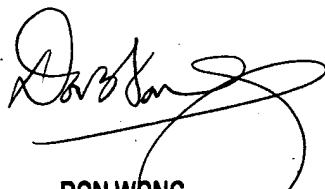
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final

action.

Contact Information

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788.

The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.
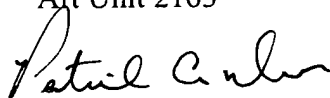
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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